

No. 11,445

United States
Circuit Court of Appeals
For the Ninth Circuit

STUART OXYGEN COMPANY, LTD.,
a corporation,

Appellant,

vs.

WILLIAM JOSEPHIAN,

Appellee.

Brief on Behalf of Appellant

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This is an appeal from a final judgment of the United States District Court for the Northern District of California, Southern Division, adjudging that Letters Patent No. 2,317,064 issued April 20th, 1943 are good and valid in law and that Stuart Oxygen Company, Ltd. has infringed said Letters Patent by making and using certain devices introduced in evidence.

JURISDICTIONAL STATEMENT

The jurisdiction of the District Court of the United States in this action is based upon the following statutory provision:

“The district courts shall have original jurisdiction as follows:

* * * * * *

“SEVENTH: Of all suits at law or in equity arising under the patent, the copyright, and the trademark laws.”

Judicial Code, Section 24;

United States Code, Title 28, Section 41.

The Complaint in this action (I, 2-3) alleges, in paragraph III thereof, that the jurisdiction is based upon the patent laws of the United States, and the Answer (I, 4-7) admits, in paragraph III, the truth of this allegation.

The appellate jurisdiction of the Circuit Court of Appeals in this action is based upon the following statutory provision:

“The circuit courts of appeal shall have appellate jurisdiction to review by appeal final decisions:

“FIRST: In the district courts in all cases save where a direct review of the decision may be had in the Supreme Court under section 345 of this title.”

Judicial Code, Section 128;

United States Code, Title 28, Section 225.

The United States District Court for the Northern District of California, Southern Division, entered in this action Findings of Fact and Conclusions of Law (I, 10-14) and a Final Judgment (I, 15-16) on May 23rd, 1946.

This judgment was a final decision in the District Court which may be reviewed by appeal in this court in accordance with the jurisdictional statute last above quoted, subject only to the provisions of the following statute:

“No appeal intended to bring any judgment or decree before a circuit court of appeals for review shall be allowed unless application therefor be duly made within three months after the entry of such judgment or decree.”

United States Code, Title 28, Section 230.

In accordance with this statute and the Rules of Civil Procedure of the District Courts of the United States, Rule 73, appellant within said three months; to-wit: on July 19, 1946, filed with the District Court a Notice of Appeal (I, 17-18).

STATEMENT OF THE CASE

The Complaint (I, 2-3) in this action charges infringement of patent No. 2,317,064 (II, 197-200) issued April 20th, 1943 to William Josephian, entitled “Tank Truck.” The Answer (I, 4-7) denies that the patent was “duly and legally issued” or was “for an invention,” and also denies infringement. A Request for Admission of Facts (I, 7-9) served and filed by defendant* was unanswered by plaintiff, and the matters of which an admission was requested are deemed admitted (Rule 36a, *Federal Rules of Civil Procedure*). These admissions established the public use in this country, more than one year prior to the

*Herein the parties will be referred to as plaintiff and defendant, as in the District Court.

filing of the application for the patent in suit, of certain devices, photographs of which were admitted in evidence as defendant's exhibits and which will be described hereinafter.

The device of the patent in suit is, fundamentally, a plate shaped, in general, like an ordinary saucer, which is adapted to have secured to it seven gas cylinders of the type in which oxygen is usually marketed. But no patent was asked for or granted claiming such an obvious use of the familiar saucer form. Instead, the claims asserted by Josephian and allowed by the Patent Office were restricted to a device in which the saucer-like base was proportioned in a specifically defined way to secure particular results which will be best understood when the history of the patented device is considered.

For many years oxygen was delivered from manufacturers to purchasers in cylinders which were handled one at a time in making deliveries (I, 44-45). It was customary, in such handling, to tip these cylinders to an approximately balanced position and roll them on an edge (I, 67).

Long before plaintiff entered the field with his device, efforts to avoid individual handling of such cylinders had resulted in the mounting of a large number of cylinders on a truck or trailer left at the premises of the user, as illustrated in Defendant's Exhibits C-1 to C-4 (II, 238-241); the mounting of a group of ten cylinders in a frame, raised above the floor so that an ordinary lift truck could get under and lift the assembly, as illustrated in Defendant's Exhibits A-1 to A-3 (II, 231-233); and the mounting of groups of four or five cylinders on a flat circular plate secured thereto for transportation as a unit, as

shown in Defendant's Exhibits B-1 to B-4 (II, 234-237). These latter units could be moved short distances by an operator in the same way as the defendant's units are moved (I, 137), but were designed also to be moved by crane in transporting or conveying them (I, 137) just as defendant's units are moved by hand trucks (I, 88-90) when they are to be moved other than very short distances.

Plaintiff is engaged in manufacturing and selling oxygen (I, 32) in competition with defendant and others. Acting under the spur of severe competition, he made a lengthy investigation of the devices which were being used by others for gas delivery before he made the device of the patent in suit (I, 47-48). With knowledge of them, he did not claim as inventive the mere substitution of a saucer-like base plate for the flat circular plate of the prior art device of Defendant's Exhibits B-1 to B-4 (II, 234-237). He limited every one of his claims (II, 200) to a structure in which the base and rim of the saucer-shaped base plate were critically proportioned to each other so as to give the structure "a second stable position" when tilted. This made possible two results: i.e.,

1. Balancing the unit in tilted position for ease of rolling; and
2. Prevention of overturning upon tipping beyond balanced position.

Josephian testified that, after inspecting others' devices, he "hit upon the idea of *balancing* the cylinders on a plate" (I, 48); that "only when you get into extremely heavy weight does it become important" * * * "to have the balance line right on the center track" (I, 71); that he

ordered "a half dozen rings and made them up and picked out what I thought was the best of different diameters" in making his device (I, 74); and that *the fact that the unit can move as far as the tilted stable position in which it stands free makes it possible to get the unit tilted to the position where the center of gravity is right over the rolling edge* (I, 75).

Plaintiff's expert likewise admitted that "there are certain advantages in having a resting position in these two positions" and that "it is preferable to have the second stable position to be stable in both directions" (I, 168-169).

The patent discloses only a seven cylinder unit although Josephian had built a four cylinder unit at the same time (I, 49-50) as shown in Plaintiff's Exhibits 3-A to 3-D (II, 202-205). The seven cylinder unit was disclosed, according to plaintiff's own statement, because "seven cylinders had more weight and for that reason would be more effective in demonstrating how *balance* could be achieved" (I, 52).

Claim 2 (II, 200), which is the broadest of the claims in suit, reads, in full, as follows:

"A truck for handling a plurality of cylindrical tanks comprising a base plate, means for holding a plurality of cylindrical tanks in fixed upright position on the top of said plate, and a basal member fastened to the bottom of said plate and having a circular periphery centrally located with respect to the periphery of said plate to support said truck in upright stable position, *said truck having a second stable position when tilted to rest on both of said peripheries only.*"

The specification of the patent in suit defines what is meant by "a second stable position" at page 2, column 1, line 59, to column 2, line 3, thereof (II, 200), in the following terms:

"In any event, the advantageous result of my invention can be accomplished by so designing the lower plate and its attached track, so that there will be a second stable position, such as that shown in Fig. 3 after the tank has been tilted. This simply means that the center of gravity 15 is to lie between vertical lines erected from contacts 7 and 20."

The defendant's gas cylinder holder, Plaintiff's Exhibits 7-A and 7-B (II, 207-208) bears a superficial resemblance to the device of the patent in suit (II, 198), in that a depression in the inner portion of the base plate gives that plate a saucer-like shape, but the relationship of the inner depression to the diameter of the entire plate is such that it has no "second stable position" but always returns to a vertical stable position if tilted and released. (I, 124-126). This is true because it is impossible for the center of gravity to move outwardly beyond, or even as far as, the point of contact of the inner portion of the base with the floor (I, 132 and 146-147). This is critical in determining that defendant's device will not have a "second stable position" and is not a mere matter of degree (I, 147). Because of this difference, defendant's units cannot be balanced for rolling upon the edge of the depression in the base plate.

The critical nature of the proportions in question was shown by plaintiff's demonstration (I, 148-149) that a very substantial increase in the thickness of the central portion

of the basal member of defendant's device was necessary to cause it to stand free in tilted position. The necessary increase in thickness was 25% of the actual thickness of the entire portion of the member; being $3/16$ of an inch (I, 149) in a member actually $3/4$ of an inch thick, as shown by Defendant's Exhibit E (II, 243).

Plaintiff, at the trial, attempted to mislead the Court with respect to the actual proportioning of the parts of this basal member, by introducing in evidence a grossly misrepresentative drawing purporting to show defendant's device (Plaintiff's Exhibit 6, II, 206), in which the thickness of the central portion of the basal member was shown by defendant, over strenuous objection by plaintiff's counsel, to be exaggerated by $58\frac{1}{2}\%$ (I, 132-134). This drawing was admitted by the Court, under the impression that Josephian had had it made under his own direction and vouched for it as a correct drawing (I, 63-64), but Josephian, on cross-examination, disavowed it and stated that his counsel had taken care of its preparation (I, 78).

The District Judge, in deciding the case, took the position that the expression "stable position" as used in the claims was not limited by the definition of that language contained in the specification (I, 176).

QUESTIONS PRESENTED

Two questions are presented by the present case:

1. Is the expression "a second stable position" as used in the patent claims to be construed as limited by the definition thereof contained in the patent specification; and

2. Does the defendant's device have "a second stable position" within the meaning of that expression construed as determined by the decision on the first question.

SPECIFICATION OF ERRORS

The errors relied upon and which will be urged are as follows:

1. The District Court erred in finding that the defendant's device in evidence as Plaintiff's Exhibit 7, illustrated in Plaintiff's Exhibits 7-A and 7-B (II, 207-208) has a "second stable position" when resting simultaneously on the edge of the base plate and on the circular depression formed in said base plate; as set forth in Finding of Fact No. 12 (I, 12).

2. The District Court erred in concluding that the phrase "stable position," as used in the Letters Patent in suit refers to any position occupied by a device of the kind disclosed, in which a material increase in force is required, to cause further motion of said truck in the direction of upset, as set forth in Conclusion of Law No. 4 (II, 13); instead of concluding that said phrase is applicable only to a position in which the center of gravity of the truck is located as defined in the specification of the patent at page 2, column 1, line 59, to column 2, line 3 (II, 200).

3. The District Court erred in finding that the circular depression in the bottom of the base plate of Plaintiff's Exhibit 7, for which has been substituted herein photographic Plaintiff's Exhibits 7-A and 7-B (II, 207-

208) is the substantial equivalent of and performs the same function as the circular track disclosed in the patent in suit, as set forth in Finding of Fact No. 14 (I, 12).

4. The District Court erred in concluding that defendant has infringed claims 1, 2, 3 and 4 of the patent in suit, as set forth in Conclusion of Law No. 5 (I, 13).

5. The District Court erred in concluding that plaintiff is entitled to an injunction as set forth in Conclusion of Law No. 6 (I, 13).

SUMMARY OF ARGUMENT

1. The Josephian patent No. 2,317,064 describes and claims a gas cylinder holder which Josephian knew to be nothing more than an improvement on previously used devices for accomplishing the same general result in substantially the same way. The asserted improvement consisted of proportioning the parts of a circular base member, previously known and used, so as to make it possible to exactly balance the unit for rolling from place to place, and also to arrest it in a "second stable position" in the event of tilting beyond the position of exact balance.

2. What was meant by the expression "second stable position" was explicitly defined in the specification of the patent and each of the claims was explicitly limited to a device having such a "second stable position." The language of the claims must be construed in accordance with the explicit definition of such language contained in the specification, and it cannot be given a contrary colloquial meaning attributed to it by an expert witness in an effort to apply it to defendant's device.

3. Josephian emphasized in his patent and his testimony, and that of his expert witness, that the patented construction had added utility and distinctive qualities by virtue of the possibility of exactly balancing it in tilted position for rolling from place to place. Only a device capable of such exact balance could have a "second stable position" as recited in the claims.

4. The doctrine of equivalents cannot be invoked to hold as an infringement defendant's device, which lacks "a second stable position" and the added utility and distinctive qualities which it imports, when, as here, the "second stable position" is explicitly brought into the claims.

ARGUMENT

THE QUESTION PRESENTED IS ONE OF CLAIM INTERPRETATION

Josephian was no pioneer in the art to which the patent in suit relates. Josephian's patent discloses and defines in its claims only a gas cylinder holder which is capable of being tilted to "a second stable position" in which it will stand free when released.

The District Judge in deciding the present case held that the defendant's gas cylinder holder illustrated in photographic Plaintiff's Exhibits 7-A and 7-B (II, 207-208) had "a second stable position" within the meaning of that expression as used in the claims of the patent in suit, even though defendant's device when tilted to such a so-called "stable position" and released would not remain there but would immediately rock back to vertical position.

In taking this position, the Court reasoned that “you would get the same general result” * * * “you would get safety against overturning, stability against overturning” (I, 171), and rejected defendant’s contention that the phrase “stable position” as used in the patent specification and its claims meant a different thing from stability in the general sense of stability against overturn (I, 171). In this the Court erred.

The present appeal thus presents a pure question of interpretation of patent claims. The relevant considerations in the determination of this question are, primarily: what meaning did the patentee ascribe in his patent specification to the claim phraseology in dispute; and secondarily, does the patented construction have added utility and distinctive qualities by virtue of its incorporation of the claimed feature described by the language in controversy. Other considerations such as the fact that the defendant’s employees were familiar with plaintiff’s commercial devices and the fact that defendant knew of the patent in suit before it designed the devices alleged to infringe are completely irrelevant to the determination of this question, because defendant is relying upon plaintiff’s explicit exclusion from the scope of the patent claims, of a device constructed and operating in the manner of that here alleged to be an infringement.

In other words, the defendant took the patent claims, interpreted them in the light of the specification as securing to the patentee all to which he was entitled when they were interpreted in the light of the definition of their phraseology contained in the specification, and being thus apprised by the claims of what was still open to it and the

rest of the public, designed the allegedly infringing device in such a way as to completely respect plaintiff's proper patent rights.

Defendant in proceeding in this manner was in complete accordance with both the spirit and the letter of the entire current of authority in the Supreme Court of the United States as expressed in *McClain v. Ortmyer*, 141 U.S. 419, in which it was said:

“The object of the patent law in requiring the patentee to ‘particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery,’ is not only to secure to him all to which he is entitled, but *to apprise the public of what is still open to them. The claim is the measure of his right to relief.*”

The essential public interest in determining what is *excluded* by patent claims as well as what is included by them has been frequently emphasized by the circuit courts of appeal including the Circuit Court of Appeals for the Ninth Circuit.

American Roll Gold Leaf Co. v. Coe Co., 212 Fed. 720 (C.C.A. 1):

“The public have a right to rely upon the language of the claims in determining how far the patentee's rights go.”

Fulton v. Powers, 263 Fed. 578 (C.C.A. 2):

“One may appropriate many of the ideas or concepts projected by specification and drawing, but it is the claim that measures both the patented invention and the infringement thereof. This rule obtains whether the patent be properly spoken of as great or small, primary or secondary.”

Wilson & Willard Mfg. Co. v. Union Tool Co.,
249 Fed. 729 (C.C.A. 9):

“It is thoroughly well established that the patentee is limited to his claim, and the patent is no broader than the claims, and if the language of the claims of the patent is clear and distinct, the patentee is bound by the language he has employed.”

The issue in this case, thus, is whether the defendant's gas cylinder holder has “a second stable position” within the meaning of that expression as used in claim 2 of the patent in suit (II, 200), and as stated in other words in claim 1 of the patent in suit. Claims 3 and 4, which are the only other claims held infringed (I, 13), incorporate by reference everything recited in claim 2.

Because of critical differences in proportioning of the parts of the base members of plaintiff's and defendant's devices, the plaintiff's device is in equilibrium when it is standing in the tilted position in which it is illustrated in Figure 3 of the patent drawing (II, 198) and as shown in photographic Plaintiff's Exhibit 3-C (II, 204); whereas, the defendant's device when similarly tilted will not stand in tilted position as will the defendant's device shown in the photograph just referred to, but will always return to the vertical position in which it is shown in the photographic Plaintiff's Exhibit 7-B (II, 208). This is true because in the patented device, tilting to the position illustrated in Figure 3 of the patent drawing (II, 198) causes the center of gravity, designated 15 in the patent drawing, to move outwardly from the position directly over the center of the base portion 11 in which it is shown in Figure 1 of the patent drawing to a position between

vertical lines erected from the point of contact 17 of the basal portion 11 with the floor and the point of contact 20 of the basal portion 8 with the floor. This is clearly described in the patent specification at page 2, column 1, line 59, to column 2, line 3 (II, 200).

On the other hand, in the defendant's device it is impossible for the center of gravity to move outwardly beyond, or even as far as, the point of contact of the inner portion of the base with the floor (I, 132 and 146-147). This is critical in determining that defendant's device will not have a "second stable position" and is not a mere matter of degree (I, 147).

**The Expression "A Second Stable Position" Must Be Construed
as It Is Defined in the Patent Specification**

It is a cardinal rule of patent claim interpretation that an uncommon word or expression in a claim is to be construed in the light of the description rather than in the light of the dictionary or of expert testimony (*Walker on Patents*, Deller's Edition, Section 271, page 1264).

The leading decision on this point is that of *Advance Rumley Co. v. John Lauson Mfg. Co.*, 275 Fed. 249 (C.C.A. 7) in which the Court said:

"This court has frequently and consistently recognized the patentee's right to be his own lexicographer, and in the present suit, regardless of the ordinary or technical meaning of the words 'throttling-valve,' we will unhesitatingly accept another definition if ascertainable from the patent, if by doing so we can give better or more accurate effect to this or other claims."

Similarly, in *Robert Esnault-Pelterie v. Chance Vought Corporation*, 56 Fed. (2d) 393 (Affirmed, 66 Fed. (2d) 474) (C.C.A. 2), the Court said:

“It is the meaning which the patentee gave to the words which is apparent from the patent itself and not the meaning according to the dictionary or any writers at the time which governs. (Cases cited.)”

The plaintiff in his patent clearly defined what is meant by the expression “a second stable position” as used in the patent claims, saying in his patent specification at page 2, column 1, starting at line 59,

“In any event, the advantageous result of my invention can be accomplished by so designing the lower plate and its attached track, so that there will be a *second stable position*, such as that shown in Fig. 3 after the tank has been tilted. This simply means that the center of gravity 15 is to lie between vertical lines erected from contacts 17* and 20.”

Plaintiff's expert, Herbert E. Metcalf, on cross-examination attempted to avoid the force of this definition contained in the patent specification by contending that it applied only to the preferred form of the invention (I, 169), but it is clear that this is the only place in the patent in which the expression “a second stable position” is found and in which a definite meaning is attributed to it. Under these circumstances, it is clear that even though the testimony to the effect that this description applies solely to the preferred form of the invention be taken as wholly true, the fact that the same expression as is defined in

*The numeral 7 as used at this point is a typographical error and should be read as 17 (I, 142).

this portion of the specification is used in claim 2 of the patent requires that the claim be limited to the preferred form. Such was the holding of the Circuit Court of Appeals for the Sixth Circuit in *Jones et al. v. Sykes Metal Lath & Roofing Co.*, 254 Fed. 91 (C.C.A. 6), in which the syllabus reads:

“A patentee may supply his own dictionary; so a claim being for roll with notches staggered, as specified, and the word ‘staggered’ being found, in the specification, only in the sentence stating the preferred form, the claim will be limited to such form.”

**The “Second Stable Position” of the Patent Specification
Gives the Patented Device Special Advantages**

A further rule of claim interpretation applicable to the present case is that where a particular claimed feature gives the device certain additional utility or distinctive qualities, the claims must be limited to cover only devices embodying such a claimed feature.

A painstaking review of the authorities supporting this rule is contained in the opinion of Circuit Judge Denison in the case of *D’Arcy Spring Co. v. Marshall Ventilated Mattress Co.*, 259 Fed. 236 (C.C.A. 6), in which it is said:

“Considering the scope of the actual invention and of claims which might well have been formulated, there would be little difficulty in finding in defendants’ second form the necessary equivalency upon which to predicate infringement, if it were not for the expressly stated requirement about the relative positions of the strips. We assume, as hereafter stated, that this requirement was not inserted under such circumstances as to estop the patentee from asserting his present theory. It follows that the case is

to be treated as one of voluntary and unnecessary limitation.”

* * * * *

“In *Keystone Co. v. Phoenix Co.*, 95 U.S. 274, 24 L.Ed. 344, the claim called for ‘wide and thin drilled eyebars * * * applied on edge.’ Defendant used round bars, flattened at the ends where eyes were drilled, and (apparently) placed on edge. Though the two forms were equivalent enough in a general way, yet since it appeared that the ‘wide and thin’ form had thereby additional utility, the claim was limited to the form specified.

“In *White v. Dunbar*, 119 U.S. 47, 7 Sup. Ct. 72, 30 L.Ed. 303, the claim specified a lining of textile fabric; defendant used a lining of paper. The main object of the invention was accomplished just as well by the paper as by the cloth; but the court, in its often-cited ‘nose of wax’ opinion, held that they were not equivalents. The principle seems to be that since cloth and paper are not always equivalent and since cloth has distinctive qualities which the patentee might have considered important, he would not be allowed to escape his express declaration that he claimed cloth only. This court has often applied the same rule.”

* * * * *

“From a review of these and other familiar cases, we think it is safe to deduce the proposition that where the claim defines an element in terms of its form, material, location or function, thereby apparently creating an express limitation, where that limitation pertains to the inventive step rather than to its mere environment, and where it imports a substantial function which the patentee considered of importance to his invention, the court cannot be per-

mitted to say that other forms, which the inventor thus declared not equivalent to what he claimed as his invention, are nevertheless to be treated as equivalent, even though the court may conclude that his actual invention was of a scope which would have permitted the broader equivalency."

* * * * *

"Plaintiff urges that this limitation pertains not to a mechanical element but only to a matter of location, and, hence, that a more liberal rule of equivalency should be applied. We cannot see that it is doctrinally important whether the element said to be missing in defendants' structure is a mechanical element or any other kind of an element."

That the plaintiff Josephian considered the "second stable position" as the same as defined in the specification to be an important feature of his invention, giving his device additional utility and distinctive characteristics, is clear from both his own testimony and that of his expert, Herbert E. Metcalf. It was admitted that the fact that the patented unit can move as far as the defined "second stable position" makes it possible to get the unit tilted to the position where the center of gravity is exactly over the rolling edge, and the unit is thus exactly balanced for rolling (I, 75), and that it becomes important to have the balance line right on the center track when extremely heavy weights such as the seven-cylinder unit disclosed in the patent are to be moved (I, 71). Metcalf in his testimony agreed that there are certain advantages in having a resting position in these two positions, meaning in having the unit so arranged as to be capable of standing at rest either in the vertical position or in the stable

tilted position (I, 168), and again on cross examination stated that "it is preferable to have the second stable position to be stable in both directions" (I, 169).

Thus it appears in the language of Judge Denison that the second stable position of the claims of the present patent imports "a substantial function which the patentee considered of importance to his invention," and that under these circumstances "the Court cannot be permitted to say that other forms which the inventor *thus declared not equivalent to what he claimed as his invention* are nevertheless to be treated as equivalent."

**THE DEFENDANT'S DEVICE HAS NO SECOND STABLE POSITION
AND LACKS THE ADVANTAGES IMPORTED THEREBY**

Notwithstanding efforts on behalf of plaintiff to confuse and mislead the Court with respect to the primary issue of this case, it was clearly established that the defendant's unit has no "second stable position," because its basal member is proportioned so that the center of gravity cannot be moved to a position between two points of contact of the basal member with the floor upon tilting of the unit. This was physically demonstrated to the Court and explained in detail by defendant's expert, Wm. A. Doble (I, 124-126).

Plaintiff obtained the introduction in evidence of a grossly misrepresentative drawing identified as Plaintiff's Exhibit 6 (II, 206) purporting to show the "Defendant's Tank Truck" standing stably in tilted position in Figure 3 thereof, and showing a purported detail of the defendant's basal member in Figure 4 thereof. This drawing was admitted by the Court under the impression that the

witness Josephian vouched for it as a correct drawing (I, 63-64), but Josephian on cross examination disavowed it and stated that his counsel had taken care of its preparation (I, 78). Defendant's attempts to show the misleading character of this drawing were strenuously resisted (I, 132-135), but in spite of such resistance, Mr. Doble, the defendant's expert, was able to show the Court that Figure 4 of Plaintiff's Exhibit 6 (II, 206) showed a $58\frac{1}{2}\%$ exaggeration of the proportions of defendant's base plate.

Later the plaintiff, attempting to demonstrate similarity between plaintiff's and defendant's devices, emphasized that an increase of $\frac{3}{16}$ of an inch in the depth of the depression in defendant's basal member would cause the defendant's device to come to rest in a stable tilted position. This was demonstrated by placing defendant's device near an edge of aluminum plate $\frac{3}{16}$ of an inch thick and tipping it over the edge of the plate until the edge of the basal member came into contact with the floor.

The true effect of this demonstration, however, was to demonstrate the critical nature of the proportions of the basal member in relation to the present invention, and that defendant in adopting the proportions it did avoided any close approach to the proportions made critical by the patent claim. For while $\frac{3}{16}$ of an inch seems superficially to be a small dimension, it must be remembered that this amount was added to a member actually only $\frac{3}{4}$ of an inch thick to begin with, making the actual increase in effective thickness a matter of 25% of the total thickness of the member.

In view of the foregoing authorities and evidence, it is therefore submitted that defendant in designing and adopt-

ing the structure charged to infringe the patent chose to forego the special utility and advantages of the patented device imported by the provision for "a second stable position." By designing its device so that it had no second stable position, defendant eliminated the possibility of tilting its device to a position in which the center of gravity was balanced over the rolling edge in such a way as to permit extremely heavy weights to be easily moved by one man. Defendant's device is not capable of being so balanced. Furthermore, in so far as the defendant's device achieves the general result of reducing the possibility of accidental overturning, it does so by totally different mode of operation than does the patented device, returning as it does always to its original vertical position instead of coming to rest in "a second stable position" in which it stands tilted in the manner of the patented device.

Superficial similarities of appearance cannot outweigh such clear evidence of lack of mechanical equivalency as is supplied by these differences in result achieved and in mode of operation.

The final judgment of the District Court should therefore be reversed and the Court directed to dismiss the Bill of Complaint on the ground that the patent in suit is not infringed by the defendant's structure.

CONCLUSION

Defendant submits that the appealed judgment should be reversed.

Claims 1, 2, 3 and 4 of the Josephian patent No. 2,317,064 are not infringed by the manufacture and use of the defendant's devices illustrated in photographic Plaintiff's Exhibits 7-A and 7-B (II, 207-208) for the reasons set forth herein.

Respectfully submitted,

NAYLOR AND LASSAGNE

THEODORE H. LASSAGNE

Attorneys for Defendant-Appellant.

Dated at San Francisco, California,
February 27, 1947.

